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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/987,886

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Kazuki Matsui

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SUITE 700

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EXAMINER

SORKOWITZ, DANIEL M

ART UNIT

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3622

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/987,886	<b>Applicant(s)</b> MATSUI ET AL.	
	<b>Examiner</b> DANIEL M. SORKOWITZ	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 19-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/04/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

***Notice to Applicant***

This Office action for application 09/987886 is in response to Applicant's response from 3/23/2009 to the restriction requirement. Applicant elects claims 13-18 without traverse, and are pending and considered below.

***Election/Restrictions***

Applicant elects claims 13-18 without traverse,. Claims 1-12 and 19-31 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

- 1. Claims 13-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

**Regarding claim 13-18**, these claims recite an apparatus that appears to comprise merely software modules that are not clearly embodied on a

computer readable medium. However, this is just descriptive material (e.g. software), which is non-statutory under 35 USC 101. MPEP 2106.01 states that “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. This descriptive material is non-statutory when claimed as descriptive material *per se*. When functional descriptive material is recorded on a computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2. Claims 13-18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

**Regarding claim 13**, this claim recites the limitation “a display displaying, on the user terminals, an advertisement requesting domain for accepting an advertisement distribution reservation”. The

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claim is generally narrative and indefinite, failing to conform with current U.S. practice. It appears to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

It is unclear as to what the "domain" is meant to entail. Is the accepting of an advertisement referring to a hyperlink or a user click?

Is a domain a type of display window? Since it is unclear as to what applicant is intending to claim, the claim itself becomes indefinite. It is further unclear what is meant by the usage of the term "reservation" and "symbolic image". Is the user requesting to view advertising by clicking an icon? What is being reserved? Can't multiple users view the same advertisement? For the purposes of applying prior art, the Examiner will interpret the term to read "displaying, on the user terminals, an image for requesting an advertisement" and the term "an advertisement distribution reservation requesting unit" to read "an advertisement request".

Claims 14-18 inherit this rejection as each depends from claim 13.

**Regarding claim 13**, this claim recite the limitation "the relevant symbolic image". There is insufficient antecedent basis for this limitation in the claim.

Claims 14-18 inherit this rejection as each depends from claim 13.

**Regarding claim 14**, this claim recite the limitation “the display position of a symbolic image”. There is insufficient antecedent basis for this limitation in the claim.

**Regarding claim 17**, this claim recite the limitation “said information displaying means”. There is insufficient antecedent basis for this limitation in the claim.

**Regarding claim 18**, this claim recite the limitation “said information displaying means”. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 3. Claims 13 and 17-18 are rejected under 35 U.S.C. 102 (b) as being anticipated by US Patent Number 5,794,210 to Goldhaber et al.**

**Regarding claims 13 and 17-18**, Goldhaber discloses an advertiser displaying its image to the users (figure 11 column 18 lines 34-55); displaying, on the user terminals, an icon for requesting an advertisement (figure 11 and figure 13 #304-310, column 18 lines 34-55, an advertisement requesting domain for accepting an advertisement distribution reservation referred to as an icon for requesting an advertisement ); detecting that a user has selected or manipulated an icon to select an ad generating and transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement and other images (column 9 line 53- 67 and column 10 lines 38-59).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 4. Claims 14-16 and 18 are rejected under 35 U.S.C. 103 (a) as being unpatentable over US Patent Number 5,794,210 to Goldhaber et al.**

**in view of over US Patent Number 5,657,049 to Ludolph et al.**

**Regarding claims 14-15 and 18,** Goldhaber discloses transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement (column 9 line 53- 67 and column 10 lines 38-59). Goldhaber does not disclose changing and managing the display position of an image in response to a user manipulation. However, Ludolph discloses detecting, saving, changing, and managing the display position of an image in response to a user manipulation (figure 9c and figure 10b #220, column 5 line 50- column 6 line 33 and column 22 lines 50-65). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine Ludolph's method of icon manipulation with the icon selection method of Goldhaber. Moving icons to perform tasks such as selecting has been used since before 1984 by the Apple Macintosh Computer to increase ease of user and fun and enjoyment by the user, e.g. dragging a file to the trash can is more fun than hitting the delete key. Further, Concerning the step of "determining whether an icon in which a manipulation is performed corresponds to the symbolic image included in the advertisement information and acquires, when the symbolic image is included in the advertisement information, the positional information relating to the symbolic image as the object of the relevant advertisement information



existing in the relevant advertisement requesting domain “; that limitation is optional, and according to the MPEP, “language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation” (MPEP 2106.II. C).

**Regarding claims 16,** Goldhaber discloses transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement (column 9 line 53- 67 and column 10 lines 38-59). Goldhaber does not disclose detecting whether other symbolic images already exist in the advertisement requesting domain and also transmits, when the other symbolic images are detected, information relating to the other symbolic images to the advertisement distributor. However, Ludolph discloses detecting, and changing display size of images in a common area based on action to the window as a whole(column 18 lines 25-65). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine Ludolph’s method of group icon manipulation with the icon selection method of Goldhaber. Selecting all the items in a folder for a common operation is faster than having to select each item separately. Further, Concerning the step of “ requesting unit detects whether other symbolic images already exist “; that limitation is optional, and according to the MPEP, “language

that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP 2106.II. C).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL M. SORKOWITZ whose telephone number is (571)270-5206. The examiner can normally be reached on Monday through Friday from 8:30AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 571.272.6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)? If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D M S/  
Examiner, Art Unit 3622

/Michael Bekerman/  
Examiner, Art Unit 3622